

RECEIVED
CENTRAL FAX CENTER
DEC 15 2006

REMARKS

This is in response to the office action dated August 17, 2006. Applicants have carefully studied the office action and have carefully studied the Primary Examiner's thoughtful response to arguments made by applicants in their response to the previous office action.

Claim 1 was rejected under 35 USC 102(b) as being anticipated by Downey (U.S. 3,420,266).

Downey is a magnetic bypass valve and indicator, not a water filter.

Downey lacks the claimed passageway communicating *between* the chamber and the filter. The Primary Examiner states that he "considers the claimed *chamber* to be the space *within and surrounded* by the cylindrical filter media, and that the passageway is e.g. that defined by seat 32 (shown figure 5). The examiner contends that the passageway can extend *through* the filter media and *still be between the filter and the chamber*, as evidenced further by the flow configuration: when the filter is clogged such that the valve opens, fluid entering port 12 flow (sic, flows) along and contacts the filter, flows through the passageway and into the chamber".

Applicants specification is instructive as to the meaning of the language of the claims. In the instant application, page 18, lines 12-16 it is stated:

"A chamber is formed between the end cap 114 and the closed end 803A of the

housing end cap 102. See, Fig. 3. Water is expelled from passageway 141 in the left end cap 114 of the filter housing and exerts a force against gate 118 causing it to rotate in a clockwise direction.” Actually reference numeral 141 indicates a port and reference numeral 129 represents the passageway between the filter and the chamber. Further at
5 page 27, lns 11 et seq. of the specification it is stated: “Water resides in this annulus and flow (sic, flows) thru filter 1513 into passageway 1529 and out port 1541 impinging upon gate 1518 rotating it clockwise.” Further, in the specification of the instant application page 33, lines 13 et seq. applicants state “Water resides in this annulus and flow (sic, flows) thru filter 1513 into passageway 1529 and out port 1541 impinging upon gate
10 1518 rotating it clockwise.”

The Primary Examiner is identifying the passageway 129/1529 as the claimed chamber and he is identifying the valve seating ring 32 as the passageway between the filter and the chamber. The claimed chamber is formed between the end cap and the closed end of the housing end cap, not within the chamber.

15 In regard to Downey, it is not understood what the Primary Examiner is trying to express wherein he states that water flows along the filter and contacts that water filter. It is believed that the Primary Examiner is asserting that water is somehow going through the surface of the filter linearly where it then turns and goes into the passageway (valve seating ring 32) and then goes through a gate. However, this argument must fail as it
20 negates the meaning of the word “between” which means an ordered relationship of

structure. Also, applicant respectfully asserts that once the filter of Downey is clogged there is no flow through the filter. The Primary Examiner's rationale destroys the meaning of the word "between".

When the filter is clogged the fuel in Downey simply avoids the filter and does not go through it at all; rather, the filter is bypassed altogether and the fuel is not filtered. Downey simply lacks a passageway communicating between the chamber and the filter.

The Primary Examiner states that further that "it is pointed out that although Downey exemplifies a fuel filter, his invention is not limited thereto (see e.g. col. 1 lines 10-15) implying that the invention of Downey is applicable for use in a water filter. The cited language of Downey, however, exemplifies that the "primary object of the invention is to provide an improved **combination fluid by-pass valve and condition indicator** therefor for use in fluid flow equipment including filters." Downey does not use the word water and it is not believed that Downey is directed to water filters in any way.

It is noted that in connection with Moore USP 3,857,277 that the Primary Examiner recognizes the existence of the chamber downstream of the flapper. That is not a completely correct interpretation but it is significant in that the Examiner is correctly defining it (the chamber) and recognizing it as a separate identifiable element of the claim.

Anticipation requires that there be an identity of invention. Anticipation requires that all elements and limitations of the claim are found within a single prior art reference.

There must be no difference between the claimed invention and the reference disclosure.

Carella v. Starlight Archery and ProLine Co., 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir. 1986). *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 198 (Fed. Cir. 1983). *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781 (Fed. Cir. 1983).

Downey is missing elements of claim 1 and as such is patentable.

Reconsideration of claim 1 is respectfully requested.

Claims 1-7, 26-27, 52 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligman (U.S. 5,017,286) in view of Parise (U.S. 6,024,867) and Moore (U.S. Patent 3,857,277).

Reconsideration of claims 1-7, 26-27, 52 and 60-63 is respectfully requested.

As understood, the Primary Examiner indicates that Heiligman '286 doesn't have a gate, sensor or passageway between the filter and the chamber. Further, as understood, the Primary Examiner suggests incorporating the electronics (elements responding to a magnetic field and integrated circuit for calculating total time water is flowing through the filter) of Parise having a removable filter into Heiligman because Parise teaches the benefit of indicating filter life. The Primary Examiner does not state how the person of ordinary skill in the art would incorporate the structure of Parise into Heiligman. Nor does the Primary Examiner reveal the resulting structure of the supposed combination/modification.

Further, the Primary Examiner indicates that Heiligman and Parise do not teach a

gate that swings between positions and which includes a magnet affixed thereto. The Primary Examiner suggests that Moore teaches a flow indicating device including a gate 20 (swinging or rotating) having a magnet attached thereto and means including reed switches 24 for detecting positions of the gate. The Primary Examiner still further suggests that it would have been obvious to a person of ordinary skill in the art to have the indicating device of Moore in the outlet flow channel of Heiligman.

The Primary Examiner does not state how the person of ordinary skill in the art would incorporate the structure of Moore into Heiligman or Parise. Nor does the Primary Examiner reveal the resulting structure of the supposed combination and modification.

Applicants note the broad, general statement of the Primary Examiner that the flapper of Moore would be positioned within the end cap of Parise which includes 7b and 18. Some initial observations are apparent and are noted at this point of the response rather than deferring them for later articulation.

Part 7b doesn't permit any room for a flapper, gate or anything else. Part 18 is a fitting. It is respectfully reiterated that it is simply not understood how the claimed gate could be mounted or installed within parts 7b and/or 18 of Parise.

It must be remembered that a person of ordinary skill in the art is a person that would not innovate. A person of ordinary skill in the art is one who thinks along the line of conventional wisdom and does not take to innovate. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293 (Fed. Cir. 1985). The Primary

Examiner has not identified why a person of ordinary skill in the art of water filters would combine the teachings of Heiligman, Parise and Moore to arrive at the invention as claimed.

Further, it is respectfully submitted that the Primary Examiner has not identified
5 the claimed chamber in any of the references, namely, Heiligman, Parise and/or Moore. Clearly, there is no chamber in any of these references and it is respectfully asserted that the rejection of the claims under §103(a) is traversed and it is also respectfully asserted that the Primary Examiner has not made an appropriate and proper prima facie rejection.

Claim 1

10 The Primary Examiner correctly observes that Heiligman does not teach a gate or gate position sensor.

The Primary Examiner correctly also observes that "Parise doesn't teach a gate that swings between positions including a magnet affixed thereto." (Emphasis ours) Parise also does not disclose a chamber in which the gate resides. Parise also does not disclose a
15 passageway communicating between the chamber and the filter. The Examiner has not identified the claimed chamber or the claimed passageway between the chamber and the filter.

The Primary Examiner states that "[i]t would have been obvious to one ordinarily skilled in the art at the time of the invention to have the indicating device of Moore in the
20 outlet flow channel of Parise..." The Primary Examiner does not identify the outlet flow

channel of Parise in which the industrial elastomeric flapper visual indicator of Moore is supposed to be mounted. Nor has the Primary Examiner identified any motivation or suggestion (explicit or implicit) in Parise as to the desirability for incorporating the industrial elastomeric flapper and visual indicator of Moore.

5 The Primary Examiner contends that the similar objects can be used in place of the ball configuration of Parise. The Primary Examiner as understood indicates that the flapper of Moore is a similar object to the ball configuration of Parise. This is not understood and just to state that the structure of Moore could be inserted somehow into the structure of Parise is not enough as this would involve the complete redesign and
10 resizing of Parise since Parise is directed toward water filtration equipment and Moore is directed toward industrial strength fluids and remote monitoring of them.

 It is not believed that Parise is suggesting that different types of flow monitors could be used. Rather, Parise may be suggesting that different types of objects may be used which are in line with the flow path. These objects such as bobs are used in flow
15 meters and the like. It is respectfully suggested that the Primary Examiner is misinterpreting Parise in this regard. **The quoted language from Parise does not mean that the structure of Moore is an object which can be used in place of the balls 115 of Parise.** It means that objects which are perhaps similar to balls such as bobs may be used in place of Parise. It is fairly common to use calibrated bobs in flow meters wherein the
20 bob resides in a tube and wherein the bob is raised or lowered based on the flow through

the tube which is typically open to view.

Parise is directed toward a sink- top water filter (with replaceable electronics) which is connected to the sink faucet and Moore is directed to industrial flow monitor having a flapper 20. Flapper 20 includes an integral bead (col. 2, lns. 14 et seq.) which is mounted in the housing by sliding bead/head 26 into the housing. Parise indicates that the electronics and the filter should be replaced together so as to insure that the electronics are initialized every time a filter is replaced.

Flapper 20 is not a gate, does not swing or rotate as suggested by the Primary Examiner, and is not a hinge. Flapper 20 bends/flexes as illustrated in Fig. 1 and as explained at col. 3, lns. 28 et seq.

MPEP, Section 2143, entitled Basic Requirements of a *Prima Facie* Case of Obviousness, indicates that "three basic criteria must be met to establish a case of prima facie evidence. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "

The references Heiligman, Parise and Moore fail to disclose the claimed chamber and the claimed passageway between the filter and the chamber. As such, a prima facie case of obviousness has not been established.

MPEP section 2143.01 indicates that the prior art must suggest the desirability of the claimed invention. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. 'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.'"

Here, it is respectfully suggested that the Primary Examiner is improperly combining the references. There is no basis for combining the references as no teaching, suggestion, or motivation is explicitly or implicitly found in the references to arrive at the instant invention as claimed. Heiligman is silent as to when to discard the filter.

Heiligman is directed toward a filter having fewer parts. Parise includes a disposable filter and disposable electronics. The assembly of Parise includes a ball and magnet associated with the removable electronics but does not include a gate. A gate cannot be installed between end cap 7b or fitting 18 of Parise or anywhere else for that matter. The Primary Examiner's suggestion that the flapper 20 of Moore be some how inserted into

Parise is not understood as there is no place to put the flapper assuming, for the sake of argument, that there is some reason or suggestion to combine Heiligman, Parise and Moore. The Primary Examiner states in response to the arguments that Moore solves the problem of flow indication which is the goal of Parise. Parise has the goal of throwing
5 away the electronics every time the filter is replaced and the Examiner's statement is not understood. First, it is not understood where the flapper of Moore would go into Parise or how it would go into Parise. Next, it is not understood if the Examiner is advocating that the flapper 20 would then be thrown out as well. Why would someone use the flapper 20 of Moore in the first place as the flow through Parise is not caustic or acidic?

10 Why would the disposable filter of Heiligman be combined with the replaceable filter and electronics of Parise? Heiligman does not refer to the need to measure or monitor the performance of the filter in determining when to replace the filter and the filter housing. Heiligman is a throw away unit where the filter and housing are discarded. What would prompt the use of the technology of Parise in Heiligman where Heiligman
15 provides for the disposal of the filter and filter housing? Further what would prompt the incorporation of the technology of Heiligman into the sink-top technology of Parise where Parise includes a replaceable filter with mandatorily replaceable electronics which include a battery which must be replaced? What would prompt use of the industrial device of Moore (which is not a gate) into the technology of Parise and Heiligman?

20 Where is the claimed chamber in Parise and Heiligman?

Applicant respectfully submits that a great leap of logic, addition of missing elements and hindsight reconstruction is required to arrive at the claimed invention as set forth in claim 1.

In *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) the court held that a
5 “finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the claimed invention] to make the combination in the manner claimed” must be made. In the instant application, the Primary Examiner has not identified a specific understanding or principle within the knowledge of the skilled artisan that would have motivated one with no knowledge of the
10 claimed invention to make the combination in the manner claimed. Nowhere does the Primary Examiner identify the artisan given the differences in the problems to be solved, nor does the Examiner explain the motivation for combining the structure of the references. Nor does the Primary Examiner identify how the references would be modified other than broad general statements without any structural basis therefor.

15 It must be remembered that a person of ordinary skill in the art is a person that would not innovate. A person of ordinary skill in the art is one who thinks along the line of conventional wisdom and does not take to innovate. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293 (Fed. Cir. 1985). The Primary Examiner has not identified why a person of ordinary skill in the art of water filters would
20 combine the teachings of Heiligman, Parise and Moore to arrive at the invention as

claimed.

Claims 2-7.

Claims 2-7 are allowable as being dependent directly or indirectly on allowable claim 1.

5 **Claim 26.**

Neither Heiligman nor Parise nor Moore taken individually or in combination disclose the claimed **wet chamber formed within the water filter housing**. As stated above, there is no way to combine the elements as asserted to arrive at the claimed invention.

10 Neither Parise nor Moore disclose the claimed **water filter non-removably contained within the water filter housing**. In fact, Parise teaches away from the claimed structure in that it specifically provides for the replacement of the filter and for the replacement of the electronics associated with the removable water filter. According to the invention defined by claim 26 when the filter is worn the device is discarded. This is
15 fundamentally different than Parise.

Heiligman, Parise and Moore do not disclose a passageway communicating between the wet chamber and the water filter.

Heiligman, Parise and Moore do not disclose a gate having a magnet affixed thereto and residing in the chamber.

20 The Examiner states that "Parise is not limited to his shown ball configuration see

e.g. the scope of his claim 1 and col. 6, line 33 which states that similar objects can be used."

It is not believed that Parise is suggesting that different types of flow monitors could be used. Rather, Parise may be suggesting that different types of objects may be used which are in line with the flow path. These objects such as bobs are used in flow meters and the like. It is respectfully suggested that the Primary Examiner is misinterpreting Parise in this regard. **The quoted language from Parise does not mean that the structure of Moore is an object which can be used in place of the balls 115 of Parise.** It means that objects which are perhaps similar to balls such as bobs may be used in place of Parise.

The ball-shaped magnet that the Primary Examiner is referring to is believed to be a bar magnet 22. It is unclear if the Primary Examiner is suggesting that the bar magnet 22 of Moore be used in place of the balls 115 of Parise. It is not believed that the bar magnet 22 of Moore could be used in place of balls 115 of Parise. The undersigned does not understand the Primary Examiner and it is respectfully suggested to the extent understood that the Primary Examiner's position is flawed.

Neither Parise nor Moore include a gate swinging between first and second positions. Flapper 20 of Moore flexes and bends but does not rotate. See Fig. 1 of Moore.

Neither Parise nor Moore include a gate position sensor in an end cap of the water

filter housing. .

The arguments made in regard to claim 1 are equally applicable to claim 26 and are not repeated here but are incorporated herein by reference. It is respectfully suggested that Heiligman, Parise and Moore are grossly insufficient as most of the claimed structure cannot be found in either reference and there is no explicit or implicit motivation to combine them as claimed. It appears that the Primary Examiner has impermissibly sifted through the art in attempt to arrive at the structure as claimed in claim 26 . This amounts to an attempt at hindsight reconstruction using unrelated bits and pieces of the references to arrive at the claimed invention as recited in claim 26. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1990); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1999).

Reconsideration of claim 26 is respectfully requested.

Claim 27

Claim 27 is patentable for at least the reason that claim 26 is patentable.

Reconsideration of claim 27 is requested.

Claim 28 was rejected under 35 USC 103(a) as being unpatentable over Heiligman in view of Parise in view of Moore as applied to claim 27 above and in further view of Downey.

Claim 28 is patentable as being dependent on patentable claim 26 for the reasons stated herein above.

First, applicants respectfully traverse the Primary Examiner's determination that a side of the filter of Downey is an end cap. It simply is not.

Neither Parise nor Moore disclose the water filter affixed to a first end cap and a second end cap. Neither Parise nor Moore disclose that the first end cap of the filter
5 includes a first hinge member and that the gate includes a second hinge member which coacts with the first hinge member to enable the gate to swing between first and second positions. Moore does not disclose hinge members and flapper 20 of Moore is not a gate as stated previously.

The Primary Examiner seems to say that it would have been obvious to have the
10 filter end caps (elements 7b + 18) of the modified Parise include the hinged gate of Downey. The Primary Examiner appears to be stating that the bypass valve of Downey should somehow be installed in Parise to arrive at the invention of claim 28. The Primary Examiner appears to be equating the cylindrical fuel filter of Downey with an end cap and then (it is believed) attempts to justify incorporation and substitution of the bypass valve
15 of Downey for the fitting and the upper end cap 7b of Parise. First, no motivation or suggestion implicit or explicit for this modification has been identified by the Primary Examiner. Secondly, the Primary Examiner has not identified why a bypass valve would be used in the first place in a situation which does not require a bypass valve.

Claim 28 is believed patentable as it is dependent on allowable and patentable
20 claim 26.

Reconsideration of claim 28 is requested.

Claim 52

Claim 52 is dependent on allowable claim 1. Reconsideration of claim 52 is requested.

5 **Claims 60-63**

Claim 60 has been amended and is now dependent on claim 1 and is patentable as claim 1 is patentable. Further, claim 60 is patentable for the following reasons.

Claims 61-63 are dependent directly or indirectly on claim 60 and are patentable for at least the reason that claim 60 is patentable. Claims 60-63 are also patentable for the reasons given above in connection with claims 1 and 26.

Reconsideration of claims 60-63 is requested.

The Primary Examiner should be aware of co-pending application serial nos. and publications, to wit: 20050092661; 11/264,239; 29/241,767; 11/256,133; 11/256,403; 11/256,132; 11/255,670; 11/255,715; and 11/256,064; all of which have been previously identified by the IDS filed with the office before the first substantive office action.

Reconsideration of claims 1-7, 26-28, 52 and 60-63 is respectfully requested.

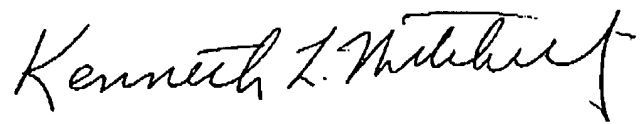
The undersigned invites a telephone call from the Examiner if it would expedite the processing and examination of the application. Applicants would like to thank the Examiner for his careful review of the application.

20 Favorable action is solicited.

If there are any additional charges, or any overpayment, in connection with the filing of the amendment, the Commissioner is hereby authorized to charge any such deficiency, or credit any such overpayment, to Deposit Account No. 23-3060.

Respectfully submitted,

Woodling, Krost and Rust



Kenneth L. Mitchell
Patent Attorney, 36873
Registered Professional Engineer
Karl Kurple
Patent Agent, 57,440
Woodling, Krost and Rust
9213 Chillicothe Road
Kirtland, Ohio 44094
phone nos. 440-256-4150;
fax nos. 440-256-7453;
cell no. 440-487-2694
clevepat@aol.com